

REMARKS

The Examiner states that the application contains claims directed to patentably distinct species. The Examiner then represents that MPEP 806.05(c) to support the proposition that the Applicant must select a single disclosed species for prosecution on the merits to which all claims shall be restricted if no generic claim is finally held allowable, and fabricates hypothetical uses for each “class” of claims. This statement mischaracterizes the standards and legal basis for a restriction requirement mandated by statute, the MPEP, and case law. Accordingly, it will be shown that the Examiner has not established a *prima facie* case for Restriction, that the Request for Restriction should be withdrawn. Accordingly, the Request for Restriction is traversed, and withdrawal of the Restriction request is requested.

Showing a Prima Facie Case of Restriction

The USPTO can require a restriction of claims if the Examiner provides a sufficient factual basis to establish, with *prima facie* evidence, that either:

- (A) a patent application claims two or more independent and distinct inventions (MPEP 802); or
- (B) separate species or classes are claimed in dependent claims as defined in MPEP §808.

(A) The Patent Office may require restriction where there are two or more independent and distinct inventions claimed in an application. The USPTO interprets the term “independent” to mean that “there is **no** disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect.” Likewise, the term “distinct” is interpreted to mean that two or more inventions are (1) capable of separate manufacture, use, or sale, as claimed, AND (2) patentable over each other. MPEP §802.01. Accordingly, to meet the *prima facie* burden for a Restriction based on independent and distinct inventions, the Examiner must (1) allege that (a) there are two independent inventions, that (b) are distinct, (2) as claimed, and (3) provide factual support for each allegation.

(B) The USPTO may require separate species or classes claimed in dependent claims to be restricted in special circumstances narrowly defined in MPEP §808.02. Specifically, an Examiner may require restriction of claims presented in a single application for related, dependent inventions that are distinct if (1) each distinct invention has a separate classification system, (2) each distinct invention has a separate status in the art, or (3) a different field of search is necessary for each distinct invention. MPEP §808.02. As stated in the Manual, [if] “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” Id.

Thus, to establish a *prima facie* case for restricting the claims of an application under the genus/species test, the Examiner needs to (1) provide reasons why the inventions *as claimed* are distinct, and (2) explain why the distinct inventions must be restricted on the basis of (a) separate classification, (b) separate status in the art, or (c) a different field of search. Id. Specific evidence must be provided for each element, along with any basis for interpreting a term. This is required, in part, so that the Applicant can ascertain whether or not the Examiner understands the invention, and so that the Applicant can frame a response. 37 CFR §1.106(b). Of course, the interpretation must rely on teachings found within the four corners of the reference. *Dewey & Almy Chem. Co. v. Mimex Co.*, 124 F.2d 986, 989 (2d Cir. 1942).

When an Examiner’s restriction requirement relies on a reason 1, the requirement must provide an appropriate explanation as to why “each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search.” MPEP §808.02 No such demonstration is made in the Office Action/Restriction Requirement. Rather, the Examiner merely relies on the naked allegation that the classes of claims *could* be used in different applications. Clearly, one “could” hypothetically use a toothpick as a weapon, a pencil as an ear-wax cleaner, or gasoline as lighter fluid. However, these hypothetical uses ignore structural limitations, and structural limitations define the claims, and thus define the invention. Rather, as pointed out by the MPEP 805, each alleged claim class has

elements in common with the other, and thus should be examined as a single invention. Accordingly, the Restriction Requirement should be removed and the application should proceed to examination.

(A) Independent Inventions

As discussed above, to meet the *prima facie* burden for a Restriction based on independent and distinct inventions, the Examiner must (1) allege that (a) there are two independent inventions, that (b) are distinct, (2) as claimed, and (3) provide factual support for each allegation.

However, in the present restriction request, the Examiner does not allege that the claims define separate and distinct inventions (only allegedly alternative uses are cited), and thus the Applicant has no duty to show otherwise. Nevertheless, each alleged claim class has elements in common with the other, and thus should be examined as a single invention. Accordingly, any restriction request based on “separate and distinct” inventions is traversed and no restriction based thereupon should be entered.

(B) Separate Species

As previously shown, the Patent Office requires that, in the case of alleging separate species, the distinctness requirement between inventions can invoke division on the basis of (1) separate classification, (2) separate status in the art, or (3) a different filed of search.

In reference to the Applicant’s invention, the Examiner requests the restriction not on a basis in fact with reference to the Applicant’s claims, but rather based on a *mere speculation* (or at most, allegation) that different patentable species may be present based on different hypothetical uses. Such reasoning, if allowed to prevail without factual support and reference to the claims, as required by MPEP §808.02, would make nearly every dependent claim of every patent application subject to restriction. This is why the patent office requires reference to the claims (MPEP §802 and §808) and sound factual findings 37 CFR §1.106(b). Of course, any

interpretation must rely on teachings found within the four corners of the reference. *Dewey & Almy Chem. Co. v. Mimex Co.*, 124 F.2d 986, 989 (2d Cir. 1942). The failure to even allege, *much less show with evidence and factual findings*, that such species would require separate classification, be viewed with separate status in the art, or require different fields of search, constitutes a failure to make the required *prima facie* case of Restriction. *In re Kelley*, 200 USPQ 560. Accordingly, withdrawal of the restriction request is proper, and hereby requested.

In fact, even if such an allegation were properly asserted, there is no basis in fact for a restriction. First, each and every identified claim relates to vehicle jacks, so there is no clear indication of separate future classification and field of search as required under MPEP §808. Further, these claims should not require separate fields of search, and should receive the same classification. Thus, there is no basis to maintain a *prima facie* case for restriction, and the request for restriction should be withdrawn.

Additional Considerations

Recently, Judge Newman, in her opinion in *In re Lee*, 277 F3d. 1338, 1343, 61 USPQ2d 1430 (Fed Cir. 2002), repeated a fundamental principle that an examiner must disclose the source of his basis for a decision:

The Board's findings must extend to **all material facts and must be documented on the record**, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense", even if assumed to derive from the agency's expertise, **do not substitute for authority when the law requires authority. *Id.***

Thus, the failure of the Examiner to identify separate species by claim (rather than mere figure numbers) is yet another reason why a *prima facie* case of restriction has not been made. In addition, such conclusionary argumentation regarding species, made without reference to a single claim, places an undue burden on the Applicant (who is presumed to be able to read the

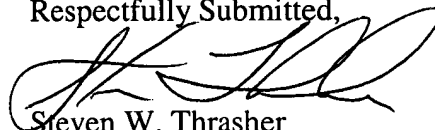
Examiner's mind and try to guess how the Examiner wants to split the claims), and fails to meet the *prima facie* requirements to show that a restriction is required. Accordingly, a *prima facie* case for restriction has not been made, and the restriction request should be withdrawn.

Conclusion

The Examiner has failed to even allege, *much less show with evidence and factual findings*, that such "species" would require separate classification, be viewed with separate status in the art, or require different fields of search. As discussed above, this is clearly required under MPEP section §802 and the failure to show this constitutes a failure to make the required *prima facie* case to force a Restriction. *In re Kelley*, 200 USPQ 560. Thus, there is no basis to maintain a *prima facie* case for restriction, and the request for restriction should be withdrawn. Nevertheless, should the Examiner maintain that the Applicant must elect a species for examination, the Applicant then elects, under protest, class 1 comprising claims 1-6, 17, 18, and 20.

If the Examiner has any other matters which remain, the Examiner is encouraged to contact the under signed attorney to resolve these matters by Examiners Amendment where possible.

Respectfully Submitted,



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